

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Michael Reed et al.

Application No.: 08/113,955

Confirmation No.: 3543

Filed: August 31, 1993

Art Unit:

For: MULTIMEDIA SEARCH SYSTEM

Examiner:

**PETITION UNDER 37 C.F.R. §1.53(b) and/or 37 C.F.R. §1.182 FOR GRANT
OF A FILING DATE AND AMENDMENT OF APPLICATION**

MS Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is a Petition under 37 C.F.R. §1.53(b) for grant of a filing date of August 31, 1993 to the above-identified application and a Petition under 37 C.F.R. §1.182 to amend the above-identified application to claim priority under 35 U.S.C. §120 to parent application 07/426,917, now U.S. Patent 5,241,671. While Petitioner believes that the requested relief may be granted under the specified rules, should there be a need to waive any other provisions of the regulations in the interest of justice, waiver is hereby requested and the Commissioner is authorized to charge any required fees for the relief sought to Petitioner's deposit account 50-2929.

BACKGROUND

1. Parent Application/Patent

Application No. 07/426,917 was filed on October 26, 1989 and eventually issued on August 31, 1993 as U.S. Patent No. 5,241,671.

2. Sandwich Applications

The law firm of Dickstein, Shapiro, *et al.*, the predecessor firm to Dickstein Shapiro LLP (hereafter “Dickstein Shapiro”) desired to file a continuation application during the pendency of the parent application. Due to certain difficulties encountered (this Petition will not elaborate on these difficulties, as they are not believed to be relevant to the issues presented herein), a continuation application was filed under 37 C.F.R. §1.53 on the date of issuance of the parent patent. This application was filed by courier delivery to the PTO. The copendency requirement of 35 U.S.C. §120 was met, as clearly addressed in MPEP 201.11. Paragraph 2.10.01 section IIB, second paragraph of MPEP 201.11 reads as follows:

“If the prior application issues as a patent, it is sufficient for the later-filed application to be copending with it if the later-filed application is filed on the same date, or before the date that the patent issues on the prior application. Thus, the later-filed application may be filed under 37 CFR 1.53(b) while the prior application is still pending before the examiner, or is in issue, or even between the time the issue fee is paid and the patent issues.”

The PTO considers an application filed on the same day that its parent is issued as one that meets the “before the patenting” language of 35 U.S.C. §120 because the PTO does not routinely stamp incoming documents with the time of receipt (only the date of receipt is affixed on most incoming correspondence, except for faxes) and because the PTO cannot always be certain of the exact time in the day when the Official Gazette (OG) would be released or patents would be released by the printer. Thus, from the perspective of time of day, an application filed on the same day would meet the statutory requirement in 35 U.S.C. §120 of being filed “before the patenting” of its parent application.

The continuation application (let us call it a 1st sandwich application) was assigned Application Number 08/113,893 and a PTO receipt date of August 31, 1993. That application included the requisite filing fee, a Declaration and a Preliminary Amendment with a claim of priority benefit under 35 U.S.C. §120 to the parent application. The routine procedure at Dickstein Shapiro was for the courier to send confirmation of filing back to the office shortly after delivery of the documents with the PTO.

The attorneys at Dickstein Shapiro were monitoring the filing of the continuation application because they were aware that the application was being filed on the last possible day. Since they did not receive confirmation of filing from the courier, in an abundance of caution, they filed another copy of the application filed earlier in the day (we will refer to this case as a 2nd sandwich application). This application was filed under 37 C.F.R. §1.53 without a filing fee and was assigned Application Number 08/113,955 and a PTO receipt date of August 31, 1993. However, in the haste of filing this 2nd application, the staff did not include a copy of the Declaration and inadvertently failed to include the Preliminary Amendment claiming priority benefit under 35 U.S.C. §120 to the parent application. This inadvertence was not caught by the attorney reviewing the filing of this application. A complete copy of the above-identified application from the Dickstein Shapiro prosecution file is enclosed herewith for the Examiner's benefit.

While the staff at Dickstein Shapiro believed that both of the sandwich applications were filed with a complete specification, notices were subsequently mailed out by the PTO in each of the sandwich applications, advising *inter alia*, that page 1 of the specification was missing. Since Dickstein Shapiro never intended to prosecute both applications, an Express Abandonment was filed on October 29, 2003 in the 1st sandwich application, with the full intention of making the necessary corrections in the 2nd sandwich application. Due to continued difficulties in obtaining the inventors' signatures, the 2nd sandwich application was eventually permitted to go abandoned in favor of a continuation application. A four month extension of time was requested on February 28, 2004 in the 2nd sandwich application.

3. Child Application/Patent

Application No. 08/202,985 was filed on February 28, 1994 as a continuation application under 37 C.F.R. §1.53 (hereafter "child application"), claiming benefit under 35 U.S.C. §120 to the 2nd sandwich application. By way of an Amendment filed on September 11, 1995, Applicant amended the Specification by inserting on page 2 thereof the following:

“This is a continuation of application Ser. No. 08/113,955, filed 8/31/93, now abandoned, which is a continuation of application Ser. No. 07/426,917, filed 10/26/89, Pat. No. 5,241,671.”. The child application matured into U.S. Patent No. 6,546,399 and was issued on April 8, 2003 as a continuation of Application No. 08/113,955 (2nd sandwich application), which is a continuation of Application No. 07/426,917 (parent application). The Patentee was unaware of any filing date or priority claim problems with the child patent until the issue was raised by an accused infringer during litigation. In the interest of full disclosure, Petitioner submits as part of this Petition a copy of a Motion for Summary Judgment filed on behalf of the accused infringer as part of *Civil Action No. 1:07-cv-787 LY before the U.S. District Court for the Western District of Texas, Austin Division*.

A more detailed chronology of events will be set forth below in order to have this Petition granted so as to remove any cloud that may hang over the child patent as a result of an inadvertent procedural oversight which was not picked up by Applicant, or the PTO.

DETAILED PRESENTATION

As outlined above, the 2nd sandwich application was filed without a Declaration, without a fee, and without an explicit claim of priority benefit to the filing date of the parent application. None of these items are required to be filed in order to obtain a filing date, as they can be filed later on, subsequent to receipt of a PTO Notice.

According to PTO records, page 1 was missing from the 2nd sandwich application as filed. On September 14, 1993, the PTO mailed out a Notice of Incomplete application, no filing date granted, setting a two month period to cure the oversight (and submit a Declaration, filing fees and surcharge) and to avoid disposal of the application. Applicant was given the option of submitting the missing page and obtain the date of submission as the filing date, or to keep the application without page 1 and retain the original filing date. Applicant opted for the latter alternative and filed on October 29, 2003 a Preliminary Amendment deleting the incomplete text on page 2 and filing a Petition for the original filing date. By way of a Decision dated February 16,

1994, the Petition was dismissed for lack of a Declaration and a two month period was set for requesting reconsideration as provided for in 37 C.F.R. §1.181(f). Applicant filed on February 28, 1994 a Request for a 4 month extension of time, paid a \$1,320 petition fee and authorized the charge of any additional fees required. On March 23, 1995, a Notice of Abandonment was mailed by the PTO in the 2nd sandwich case.

According to PTO records, page 1 was missing from the 1st sandwich application. The PTO mailed on October 1, 1993 a Notice of Incomplete application. Since Applicant only intended to prosecute one of the two sandwich applications filed, a decision was made to expressly abandon one of them. Given that both sandwich applications were missing page 1 according to PTO records, and since the 1st sandwich application included the Declaration, the filing fees and the proper claim of priority to the parent application, it would have made sense to expressly abandon the 2nd sandwich application. While details of what transpired some 14 years ago can no longer be recalled, it would appear that, possibly due to confusingly similar docket numbers, the express abandonment was filed in the 1st sandwich application without realizing that the filing fee and Declaration still had to be filed in the 2nd sandwich application (which also did not include the express claim of priority in a manner claimed in the 1st sandwich application). The express abandonment was filed in the 1st sandwich application on October 29, 1993.

The child application was filed on February 28, 1994. This child application was filed without page 1 of the Specification and without the Declaration. The prosecution history of the child application will not be discussed at length since the relevant issues to the relief sought herein are only present in the sandwich applications. Insofar as the relevant issues are concerned, the child application claimed priority benefit under 35 U.S.C. §120 to the 2nd sandwich application at the time of filing and was amended to claim priority benefit under 35 U.S.C. §120 to the parent application. The PTO decision of September 15, 1995 granted a filing date of February 28, 1994, granted treatment of the application under 37 C.F.R. §1.47 and made no reference to any problems in the claim of priority to the 2nd sandwich application. Thus, Applicant was not alerted to any filing date or priority benefit problems. On the contrary, on the face of the issued child patent, the PTO

explicitly confirmed benefits under 35 U.S.C. §120 to the 2nd sandwich application and to the parent application.

RELIEF REQUESTED

1. Petitioner requests that this Petition be considered on its merits, in spite of being filed outside the two month period set in the decision of February 20, 1994 in the above-captioned application (the 2nd sandwich application). That decision referred to 37 C.F.R §1.181(f) for support of the deadline being set at two months. However, that two month period is not a statutory period for response. As clearly stated in 37 C.F.R §1.181(f), “[A]ny petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided.” (emphasis added). A Petition for Reconsideration was not filed earlier simply because Applicant was not alerted to the fact that the 2nd sandwich application did not include a claim of priority benefit to the parent application. Furthermore, the PTO contributed to Applicant’s false sense of security by its positive act of granting the petition filed in the child application without alerting Applicant to corrective steps that could have been taken earlier in the 2nd sandwich application. The equity is clearly on the side of Applicant and justice requires that the relief sought herein be granted on the basis of:

(a) examination of the child application proceeded as if a Petition for Reconsideration had been timely filed and granted in the 2nd sandwich application;

(b) the general public could not have relied on a belief that priority benefits were not being claimed because the public was not aware of any errors in the 2nd sandwich application since that application was not publicly available;

(c) the child application provided clear notice to the Examiner as well as to the general public that benefits under 35 U.S.C. §120 were being claimed to the filing date of the parent application via the 2nd sandwich application; and

(d) the interests of the patent owner of the child application could be severely harmed if a cloud of uncertainty were permitted to exist over the effective filing date of the child application which matured into patent 6,546,399. The PTO has recognized the unfairness of the harsh consequences that applicants may suffer when a filing date is not granted under these types of circumstances. While this application was being processed by the PTO based on the practice at the time, the practice was subsequently changed (Petitioner is uncertain of the exact date of change, though it might have been sometime in June 1994) to grant a filing date in situations where a page is missing from the application as filed. Thus, the current version of the MPEP, section 601.01(d) calls for a filing date to be granted to an application filed with a missing page even if applicant fails to respond to a "Notice of Omitted Item(s)" (see MPEP 601.01(d) section I(C)(1)). While this change in practice was not in effect at the relevant time, it should be a factor in the deciding official's consideration of proper relief to be granted in this case.

2. Petitioner requests that the PTO apply the extension of time fee tendered on February 28, 2004 to any required filing fee in the above-captioned application (the 2nd sandwich application), or the retention fee necessary to permit priority benefits under 35 U.S.C. §120 for the child application. Since the PTO would have no reason to collect extension of time fees in an application that was not granted a filing date, this excess fee collected could be applied to any retention fees or filing fees required. Additionally, any shortages in the fees paid could have been charged in accordance with the general authorization provided in the February 28, 1994 filing of the request for extension of time. If the PTO is unable to apply the fees already paid or to charge the required fees in this manner, then authorization is hereby given to have any required fees charged to Petitioner's deposit account 50-2929.

3. Petitioner requests by way of a separately filed Amendment that the above-identified Application be amended to reflect the deletion of page 1 and that the priority claim read as follows:

On page 2 before line 1, please insert the following: -- This is a continuation of Application No. 07/426, 917, filed October 26, 1989, now U. S. Pat. No. 5,241,671. - -

4. Insofar as the doctrine of laches is concerned, Petitioner is simply asking that this Petition be granted to establish a clear line of priority benefits from the child application to the parent application by having a filing date of August 31, 1993 granted to the above-captioned application (the 2nd sandwich application). Once a filing date is granted, the deciding official is authorized to abandon the present application effective February 29, 1994 in favor of the child application which matured into a patent.

CONCLUSION

Grant of the Petition and relief outlined above are respectfully requested.

To the extent that any filing fees, document retention fees or other fees are owed to the Patent Office regarding the above-captioned Application, the Commissioner is authorized to charge such fees to Petitioner's Deposit Account No. 50-2929, making reference to docket number J8300.1.

To the extent determined *sua sponte* by the Commissioner or his designee, Petitioner also requests suspension of the rules under 37 C.F.R. §1.183 if necessary, and authorizes payment of any required petition fees thereunder by charging Deposit Account 50-2929.

Petitioner is uncertain as to the charges that the deciding official will deem necessary. Accordingly, no payment is enclosed. Rather, payment of any fees required to grant, on an expedited basis, a filing date of August 31, 1993 to the above-captioned application, and to amend the above-captioned application to include the above-noted claim of priority benefits under 35 U.S.C. §120 are hereby authorized to be charged to Deposit Account 50-2929, making reference to docket number J8300.1.

Dated: November 1, 2007

Respectfully submitted,

By 

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